

## **R E M A R K S**

The office action of June 30, 2004 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 24 remain in this case, claims 1-21 being amended, and claims 22-24 being added by this response. The claims were amended merely to clarify the subject matter being claimed. No new matter has been added. Specifically, support for the amended and new claims can be found on page 3, line 15 through page 5, line 17.

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

### **Objection to the Oath**

1. The Examiner stated that the oath was defective because it was not executed in accordance with 37 CFR 1.53(b) or 1.53(d). More specifically, the Examiner stated that “the claims that have been presented in the instant application are not as originally filed in the parent application, 09/299,370, which may raise a new matter.” (present office action dated June 30, 2004, page 2, lines 4-6).

The Applicant’s agent telephoned Examiner Ephrem Alemu for clarification of this objection on July 9, 2004. The Examiner stated that, when we file a divisional application, any changes must be made in a preliminary amendment, and that the new claims could be new matter. The Applicant’s agent explained that she has filed many divisional applications in this format in the past. In addition, even assuming he was correct, she explained that it was unclear how that makes the oath defective.

The Applicant’s agent also explained that the oath was newly executed for the divisional application (see oath dated December 14, 2001), and that no new matter had been added in the claims.

The Examiner stated that, in order to overcome the rejection, the response should state that no new matter has been added in the claims, and that the oath was newly executed for this application. The Applicant gratefully thanks the Examiner for his suggestions.

The claims in the present application are fully supported by the application, as filed. No new matter has been added. In addition, the oath in this application was newly executed on December 14, 2001. Therefore, reconsideration and withdrawal of the objection is respectfully requested.

### **Objections to the Drawings**

2. The drawings were objected to because Figs. 15-17 were not included in the drawings.

Although Figs. 15-17 were included in the patent application, as filed, the Applicant is including another copy of these figures with this response. Reconsideration and withdrawal of the objection is respectfully requested.

3. The drawings were objected to for not showing every feature of the invention specified in the claims. The claims have been amended to overcome this rejection.

As amended, the claims include an erase address waveform, a ramped voltage address waveform, and/or a write address waveform. As discussed above, no new matter has been added. In addition, these waveforms are shown in the drawings, as filed. More specifically, Figure 2 shows an erase address waveform, Figure 3 shows a write address waveform, and Figure 4 shows a ramp voltage address waveform. Reconsideration and withdrawal of the objection is respectfully requested.

### **Objection to the Specification**

4. The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. Applicant respectfully disagrees.

The three address waveforms are fully supported by the specification on page 3, line 15 through page 5, line 17, page 7, lines 18-19 and on page 16, lines 16-27. In addition, three paragraphs have been added to the Summary of the Invention. No new matter has been added. Specifically, these paragraphs are fully supported by the claims and specification, as filed, as well as by original claims 2-4, as filed in the parent application on April 26, 1999.

Reconsideration and withdrawal of the objection are respectfully requested.

## Double Patenting Rejections

6. Claims 1-21 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,570,339.

Although the Applicant respectfully disagrees, to further prosecution of the application, a terminal disclaimer is being filed with this response. Reconsideration and withdrawal of the rejection is respectfully requested.

7. Claims 1-21 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-48 of U.S. Patent No. 5,984,747 in view of Applicant's admitted prior art (Figs. 2-4 and specification describing these figures).

The Applicant's agent spoke to the Examiner regarding this rejection during their July 9, 2004 telephone conversation. During the conversation, the Applicant's agent requested clarification and the legal authority supporting the propriety of citing two or more references in a double patenting rejection. The Applicant's agent knows of no legal authority for a double patenting rejection combining multiple references. The Applicant's agent pointed to the following paragraph in the M.P.E.P., which distinguishes a double patenting rejection from an obviousness rejection under 35 U.S.C. 103. "One significant difference is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent. In a 35 U.S.C. 102(e)/103(a) rejection over a prior art patent, the reference patent is available for all that it fairly discloses to one of ordinary skill in the art, regardless of what is claimed. *In re Bowers*, 359 F.2d 886, 149 USPQ 570 (CCPA 1966)." (M.P.E.P. 804 III, emphasis added).

The Examiner responded by pointing to the following section of the M.P.E.P. Form Paragraph "8.36 Rejection, Obviousness Type Double Patenting- With Secondary Reference(s) Claim [1] rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of U.S. Patent No. [3] in view of [4]. [5]" (M.P.E.P. 804 (b), form paragraph sections for Examiners). This note for Examiners continues on, describing what

information should be included in each bracketed section. Since this is only Examiner's instructions, and does not explain when, if ever, this type of rejection is permitted, the Applicant's agent asked the Examiner to point to the legal authority (i.e.- sections of the 37 CFR or 35 USC) supporting a double patenting rejection combining two or more references. The Examiner told the Applicant's agent that he would look into it, and would call the Applicant's agent back.

Later that day, the Applicant's agent received a voice mail message from the Examiner, where he stated that the support can be found in Section 804 B. NonStatutory Double patenting, 1. Obviousness Type. He stated that, since this section states that double patenting rejections are analogous to 35 U.S.C. 103 rejections, a secondary reference can be applied in a double patenting rejection.

The Applicant's agent believes that the Examiner is referring to the following passage from the M.P.E.P. "A double patenting rejection of the obviousness-type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite* 379 F.2d 594, 154 USPQ 29 (CCPA 1967)." (M.P.E.P. 804 B1). This passage says nothing about using a secondary reference to support a double patenting rejection.

This section of the M.P.E.P. further clarifies analysis for double patenting rejections. "When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure. The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*. Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970)... According to the court [in *Vogel*], one must first **'determine how much of the patent disclosure pertains to the invention claimed in the patent'** because only **'[t]his portion of the specification supports the patent claims and may be considered.'** The court pointed out that 'this use of the

disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.” (M.P.E.P. 804 B1, emphasis added).

The above passage of the M.P.E.P. clearly states that only the claims of the issued patent can be considered when determining whether there is double patenting. The disclosure in the issued patent is only used to the extent that it explains the claims. The analysis is strictly limited to the claims in a single issued U.S. Patent. Therefore, it would necessarily follow that disclosures from other sources, independent of the issued patent, can not be used to support a double patenting rejection.

In addition, “[a] second significant difference [between double patenting and a 103 rejection] is that a terminal disclaimer cannot be used to obviate a rejection based on 35 U.S.C. 102(e)/103(a) prior art. *In re Fong*, 378 F.2d 977, 154 USPQ 256 (CCPA 1967). The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing the potential harm to the public by issuing a second patent, and not to remove a patent as prior art.” (M.P.E.P. 804 III). During the telephone conversation between the Applicant’s agent and the Examiner, the Applicant’s agent asked the Examiner how a terminal disclaimer could obviate this rejection, since it relies on more than one reference. The Examiner stated that a terminal disclaimer would still be proper to obviate a double patenting rejection relying on more than one reference. Applicant respectfully disagrees.

Although double patenting and 103 rejections rely on a standard of obviousness, that is where the analogy ends. In addition, since a terminal disclaimer removes the potential harm to the public of issuing a second patent, using two references for a double patenting rejection is not proper.

In addition, a terminal disclaimer includes “a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life.” (M.P.E.P. 804.03 I). The inventor of the present application is also an inventor on U.S. Patent No. 5,984,747. Since the filing of the present application, the inventor of the present application has obtained a license to the technology in U.S. Patent No. 5,984,747. However, the

present invention is not assigned to Corning Incorporated, the assignee of U.S. Patent No. 5,984,747. Thus, the Applicant cannot file a terminal disclaimer to obviate this rejection, because it is not commonly owned with U.S. Patent No. 5,984,747 and would therefore be unenforceable from the date of issue. Therefore, a terminal disclaimer would not be proper with respect to U.S. Patent No. 5,984,747.

Therefore, since the double patenting rejection is improper, the Applicant respectfully requests the rejection be withdrawn.

However, in order to expedite prosecution of the application, the Applicant will alternatively treat this rejection as one under 35 U.S.C. 103.

U.S. Patent No. 5,984,747 does not teach or suggest connecting wires directly to a drive control system, or addressing an image using an erase, write, or ramped voltage address waveform. Instead, this patent describes glass structures for information displays.

Figs. 2-4 of the present application describe “three address modes of operation for a standard AC plasma display: (1) erase address (U.S. Pat. No. 5,446,344), (2) write address (U.S. Pat. No. 5,661,500), and (3) ramped voltage address (U.S. Pat. No. 5,745,086)” (present application, page 3, lines 15-17). Prior to the present application, these address modes of operation were used only for a standard AC plasma display.

The Examiner states that “it would have been obvious to one having ordinary skill in the display art at the time the invention was made to provide an erase address drive control system or a write address drive control system or a ramped voltage address drive control system to the fiber plasma display device of US Patent No. 5,984,747... for no other reason than driving the fiber plasma display device.” (present office action dated June 30, 2004, page 5, lines 1-5).

When features of prior art references are combined or modified to establish obviousness, the mere possibility of such a combination or modification does not render the result of that combination obvious, absent a logical reason of record which justifies the combination or modification. In re Regel, 526 F.2d 1399, 188 USPQ 136 (CCPA 1975). Instead, references may only be modified when (1) the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or perform the claimed process, and (2)

that those of ordinary skill in the art would have a reasonable expectation of success of making the claimed composition or performing the claimed process. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Thus, there must be a reason apparent to one skilled in the art at the time of the invention for applying the teaching at hand, or the use of the teaching as evidence of obviousness entails prohibited hindsight. Graham v. John Deere Co., 383 US 1, 148 USPQ 459 (1966). A relatively recent case from the CAFC amplifies this basic tenet and is quoted at length here.

*"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also Graham, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.*

*We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g.,*

*C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references."

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Further, in Dickinson v. Zurko, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that a reviewing court must apply the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. § 706 (1994), see Zurko, 119 S. Ct. at 1818, 50 USPQ2d at 1931-32.

Section 706 reads in relevant part as follows:

"§ 706. Scope of Review

The reviewing court shall--

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(2)hold unlawful and set aside agency action, findings, and conclusions found to be--

(A)arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

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(E)unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute."



5 U.S.C. § 706(2)(A), (E) (1994) (emphasis added).

Subsequently, in In Re Gartside, the Court of Appeals for the Federal Circuit held that section 144 explicitly provides that a court must review Board decisions "on the record" developed by the PTO (see 35 U.S.C. § 144 (1994) ("The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office.") (emphasis added)), and it is for this reason that the Commissioner is required to convey the record to the court in the event of an appeal. See Id. § 143. Moreover, the "hearing" upon which the "record" is based is "provided by" 35 U.S.C. § 7(b), which states that:

*"The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a) of this title. Each appeal and interference shall be heard by at least three members of the Board of Patent Appeals and Interferences, who shall be designated by the Commissioner. Only the Board of Patent Appeals and Interferences has the authority to grant rehearings."*

35 U.S.C. § 7(b) (1994) (emphasis added). Thus, the plain language of §§ 7 and 144 of Title 35 indicates that the courts must review Board decisions "on the record of an agency hearing provided by statute," and that they must therefore review Board factfinding for "substantial evidence." See also Thomas Leonard Stoll, A Clearly Erroneous Standard of Review, 79 J. Pat. & Trademark Off. Soc'y 100, 106 (1997) (arguing in favor of "substantial evidence" review based on 35 U.S.C. §§ 7(b) and 144).

Further, in Gartside, the court stated that:

*"In appeals from the Board, we have before us a comprehensive record that contains the arguments and evidence presented by the parties, including all of the relevant information upon which the Board relied in rendering its decision. See 35 U.S.C. § 143 (1994) ("[T]he Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office."). That record, when*

*before us, is closed, in that the Board's decision must be justified within the four corners of that record. The record before us on appeal thus dictates the parameters of our review. We cannot look elsewhere to find justification for the Board's decision. Furthermore, the record reflects the results of a proceeding in the PTO during which the applicant has been afforded an opportunity to bring forth the facts thought necessary to support his or her position. Accompanying the record is a detailed opinion from the Board. We have expressly held that the Board's opinion must explicate its factual conclusions, enabling us to verify readily whether those conclusions are indeed supported by "substantial evidence" contained within the record. See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").*

*In addition to the statutory language discussed above, Supreme Court precedent and the law of our sister circuits also indicate that "substantial evidence" review is appropriate in view of the plenary nature of the record before us. The Supreme Court has stated generally that the "basic requirement" for "substantial evidence" review is that the agency hearing produce a record that serves as the foundation for the agency's action. See *Overton Park*, 401 U.S. at 415; *Camp v. Pitts*, 411 U.S. 138, 141 (1973) (noting that "substantial evidence" review "is appropriate when reviewing findings made on a hearing record"). In *Zurko* the Court echoed these prior decisions when it intimated that "substantial evidence" review is the appropriate standard for our review of Board factfinding. See *Zurko*, 119 S. Ct. at 1823, 50 USPQ2d at 1936 ("A reviewing court reviews an agency's reasoning to determine whether it is 'arbitrary' or 'capricious,' or, if bound up with a record-based factual conclusion, to determine whether it is supported by 'substantial evidence.'"). . . .*

*Because our review of the Board's decision is confined to the factual record compiled by the Board, we accordingly conclude that the "substantial evidence" standard is appropriate for our review of Board factfindings. See 5 U.S.C. § 706(2)(E)."*

See generally In Re Robert J. Gartside and Richard C. Norton, 99-1241 Interference No. 103,255 (Fed. Cir. 2000).

Thus, to establish a *prima facie* case of obviousness, the Examiner is required to cite a combination of prior art that not only teaches each and every element of the rejected claims, but also is required to cite substantial evidence to support the conclusion that one of ordinary skill in the art would be motivated to combine or modify the references as suggested, as well as substantial evidence that one of ordinary skill in the art would have a reasonable expectation of success in making the cited combination or modification.

Even if U.S. Patent No. 5,984,747 and Figs. 2-4 of the present application, in combination, disclosed all of the limitations of the claims (which Applicant maintains they do not), there is no evidence of record showing any motivation to combine the two references to teach or suggest the subject matter claimed.

The Examiner is required to cite substantial evidence to support the conclusion that one of ordinary skill in the art would be motivated to combine or modify the references as suggested, as well as substantial evidence that one of ordinary skill in the art would have a reasonable expectation of success in making the cited combination or modification. Applicants respectfully submit that the Examiner has not met this burden, and any obviousness rejection would be based on hindsight in light of the present application. Therefore, the claims are not obvious over 5,984,747 in view of Figs. 2-4 of the present application.

8. Claims 1-21 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-54 of U.S. Patent No. 6,452,332 in view of Applicant's admitted prior art (Figs. 2-4 and specification describing these figures).

The Applicant's agent spoke to the Examiner regarding this rejection during their July 9, 2004 telephone conversation. During the conversation, the Applicant's agent requested clarification and the legal authority supporting the propriety of citing two or more references in a double patenting rejection. The Applicant's agent pointed to the following paragraph in the M.P.E.P., which distinguishes a double patenting rejection from an obviousness rejection under 35 U.S.C. 103. "One significant difference is that a double patenting rejection must rely on a

comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent. In a 35 U.S.C. 102(e)/103(a) rejection over a prior art patent, the reference patent is available for all that it fairly discloses to one of ordinary skill in the art, regardless of what is claimed. *In re Bowers*, 359 F.2d 886, 149 USPQ 570 (CCPA 1966).” (M.P.E.P. 804 III, emphasis added).

The Examiner responded by pointing to the following section of the M.P.E.P. Form Paragraph “8.36 Rejection, Obviousness Type Double Patenting- With Secondary Reference(s) Claim [1] rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of U.S. Patent No. [3] in view of [4]. [5]” (M.P.E.P. 804 (b), form paragraph sections for Examiners). This note for Examiners continues on, describing what information should be included in each bracketed section. Since this is only Examiner’s instructions, and does not explain when, if ever, this type of rejection is permitted, the Applicant’s agent asked the Examiner to point to the legal authority (i.e.- sections of the 37 CFR or 35 USC) supporting a double patenting rejection combining two or more references. The Examiner told the Applicant’s agent that he would look into it, and would call the Applicant’s agent back.

Later that day, the Applicant’s agent received a voice mail message from the Examiner, where he stated that the support can be found in Section 804 B. NonStatutory Double patenting, 1. Obviousness Type. He stated that, since this section states that double patenting rejections are analogous to 35 U.S.C. 103 rejections, a secondary reference can be applied in a double patenting rejection.

The Applicant’s agent believes that the Examiner is referring to the following passage from the M.P.E.P. “A double patenting rejection of the obviousness-type is ‘analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103’ except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite* 379 F.2d 594, 154 USPQ 29 (CCPA 1967).” (M.P.E.P. 804 B1). This passage says nothing about using a secondary reference to support a double patenting rejection.

This section of the M.P.E.P. further clarifies analysis for double patenting rejections. “When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure. The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*. Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970)... According to the court [in *Vogel*], one must first ‘**determine how much of the patent disclosure pertains to the invention claimed in the patent**’ because only ‘[t]his portion of the specification supports the patent claims and may be considered.’ The court pointed out that ‘this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.’ (M.P.E.P. 804 B1, emphasis added).

The above passage of the M.P.E.P. clearly states that only the claims of the issued patent can be considered when determining whether there is double patenting. The disclosure in the issued patent is only used to the extent that it explains the claims. Therefore, it would necessarily follow that disclosures from other sources, independent of the issued patent, can not be used to support a double patenting rejection.

In addition, “[a] second significant difference [between double patenting and a 103 rejection] is that a terminal disclaimer cannot be used to obviate a rejection based on 35 U.S.C. 102(e)/103(a) prior art. *In re Fong*, 378 F.2d 977, 154 USPQ 256 (CCPA 1967). The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing the potential harm to the public by issuing a second patent, and not to remove a patent as prior art.” (M.P.E.P. 804 III). During the telephone conversation between the Applicant’s agent and the Examiner, the Applicant’s agent asked the Examiner how a terminal disclaimer could obviate this rejection, since it relies on more than one reference. The Examiner stated that a terminal disclaimer would still be proper to obviate a double patenting rejection combining multiple references. Applicant respectfully disagrees. Although double patenting and 103 rejections rely on a standard of

obviousness, that is where the analogy ends. In addition, since a terminal disclaimer removes the potential harm to the public of issuing a second patent, using two references for a double patenting rejection is not proper.

U.S. Patent 6,452,332 is not prior art for 35 U.S.C. 103 purposes. U.S. Patent No. 6,452,332 was filed on April 26, 1999, the same day that the parent case for the present application was filed.

Therefore, since the double patenting rejection is improper and a 35 U.S.C. 103 rejection would also be improper, the Applicant respectfully requests the rejection be withdrawn.

### **Conclusion**

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

Moore

By: 

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